

REMARKS

Examiner Addy contacted the undersigned to request production of a previously submitted RCE. Examiner Addy informed the undersigned that receipt of the papers is indicated by IFW. However, apparently some portion of the prior submission is missing and the submission cannot be properly entered into the image filewrapper system for further action by the Examiner. Efforts to identify the missing pages have been unsuccessful. A check of the PAIR system provides no record of the prior submission even though the Examiner has informed the undersigned that IFW internally confirms receiving the prior communication.

The undersigned previously prepared and submitted an RCE for the present application on October 24, 2007. The undersigned refers the Examiner to the accompanying papers including copies of the RCE transmittal, Amendment, metered envelope, copies of the postcards submitted on October 24, 2007 and copies of the postcards returned.

The postcards submitted by the undersigned indicated the contents of the prior communication. The postcards identify the postcards, RCE transmittal (2 pages) and duplicate, request for Extension of Time, and the Amendment (4 pages). Please note also the October 24, 2007 mailing date on the return postcards which is consistent with all the other evidence regarding the date of deposit. Each of the return postcards was stamped by the Patent Office with an October 29, 2007 receipt date thus acknowledging receipt of the items identified on the postcards.

When communications are to be mailed to the USPTO, the undersigned has an office policy of photocopying the envelope prior to mailing the communications to the USPTO. Please refer to the enclosed photocopy of the metered envelope. The notations on the address label identify the undersigned's docket number and client docket number thus associating the envelope with the present application. The envelope was metered with the October 24, 2007 date –

the date the envelope was deposited with the United States Mail in accordance with postal regulations regarding metered mail.

Referring to the RCE and Amendment, applicant notes that the transmittal sheet, duplicate of the transmittal sheet, and amendment *each* include an executed certificate of mailing in compliance with 37 C.F.R. § 1.8. The certificates of mailing indicate an October 24, 2007 date of deposit. The certificates of mailing are also consistent with the metered date of the envelope and the mailed date indicated on each of the returned postcards.

Applicant respectfully submits that sufficient evidence has been provided to document that the materials were deposited with the U.S. Postal Service on October 24, 2007 and that such materials were actually received by the USPTO. In accordance with 37 C.F.R. § 1.8, applicant respectfully requests that the Patent Office recognize applicant's October 24, 2007 mailing date of the requested materials. In particular, the RCE and Amendment were timely filed and received by the USPTO despite any mishaps that subsequently rendered the communication unavailable at the USPTO.

If there are any issues that can be resolved by telephone conference, the Examiner is respectfully requested to contact the undersigned at (512) 858-9910.

Respectfully submitted,

Date February 25, 2008

William D. Davis
William D. Davis
Reg. No. 38,428



HEWLETT PACKARD COMPANY
Attn: Patricia Ashkanani
Legal Department, MS 79
3404 EAST HARMONY ROAD
FORT COLLINS, CO 80528



Application/Patent No: 10/602,444 Filing/Issue Date: 06/24/2003
Title: INTERMEDIATE PACKETIZING OF VOICE DATA FOR COMMUNICATION BETWEEN CIRCUIT-SWITCHED NODES
Inventors: Michael D. Oldham & Christopher C. Jones
Client: Hewlett Packard Co. Client Docket No: 100200681-1
Date Mailed: 10/24/2007 Our Docket No. 28475P003901 Docket Due Date: 10/24/07

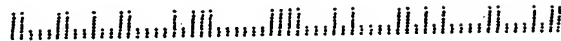
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| <input checked="" type="checkbox"/> Certificate of Mailing | <input type="checkbox"/> Express Mail No: _____ | <input type="checkbox"/> Check No: _____ |
| <input checked="" type="checkbox"/> Postcard | <input checked="" type="checkbox"/> Petition for <u>1</u> months extension of time | Amt: \$ _____ |
| <input type="checkbox"/> Application Utility - (____ pgs w/o cover) | <input type="checkbox"/> Preliminary Amendment (____ pages) | <input type="checkbox"/> Check No: _____ |
| <input type="checkbox"/> Application Utility Continuation (____ pgs w/o cover) | <input checked="" type="checkbox"/> Amendment/Response (<u>4</u> pgs) | Amt: \$ _____ |
| <input type="checkbox"/> Application Utility Divisional (____ pgs w/o cover) | <input type="checkbox"/> Notice of Appeal | <input type="checkbox"/> Check No: _____ |
| <input type="checkbox"/> Application Utility CIP (____ pgs w/o cover) | <input type="checkbox"/> Appeal Brief (____ pgs) | Amt: \$ _____ |
| <input type="checkbox"/> Application Design (____ pgs) | <input type="checkbox"/> Reply Brief (____ pages) | <input type="checkbox"/> Check No: _____ |
| <input type="checkbox"/> Application PCT (____ pgs) | <input type="checkbox"/> Information Disclosure Statement & PTO-1449 (____ pgs) | Amt: \$ _____ |
| <input type="checkbox"/> Application Provisional (____ pgs) | <input type="checkbox"/> Issue Fee Transmittal | |
| <input type="checkbox"/> Drawings: ____ sheets including ____ figures | <input type="checkbox"/> Transmittal Letter in duplicate | |
| <input type="checkbox"/> Response to Notice of Missing Parts | <input type="checkbox"/> Fee Transmittal in duplicate | |
| <input type="checkbox"/> Declaration & Power of Atty (____ pgs) (unsigned) | | |
| <input type="checkbox"/> Assignment & Cover Sheet | | |

☒ Other - Request for Continued Examination Transmittal including Deposit Account Authorization (2 pgs & duplicate), 2d return postcard



|||||
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| <input type="checkbox"/> Application Utility CIP (____ pgs w/o cover) | <input type="checkbox"/> Appeal Brief (____ pgs) | Amt: \$ _____ |
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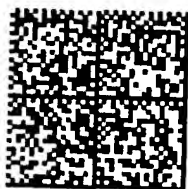
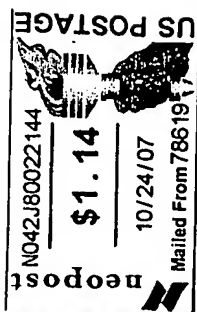
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Alexandria, VA 22313-1450



28475 P02 3901
100200 681-1



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Attn: Patricia Ashkanani
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☒ Other - Request for Continued Examination Transmittal including Deposit Account Authorization (2 pgs & duplicate), 2d return postcard

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400



PATENT APPLICATION

ATTORNEY DOCKET NO. 100200681-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael D. Oldham, et al.

Confirmation No.: 9424

Application No.: 10/602,444

Examiner: Addy, Thjuan Knowlin

Filing Date: June 24, 2003

Group Art Unit: 2614

Title: Intermediate Packetizing of Voice Data for Communication Between Circuit-Switched Nodes

Mail Stop RCE
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CONTINUED EXAMINATION (RCE) 37 CFR 1.114

Subsection (b) of 35 U.S.C. 132, effective on May 29, 2000, provides for continued examination of a utility or plant application filed on or after June 8, 1995.

See The American Inventors Protection Act of 1999 (AIPA).

This is a Request for Continued Examination (RCE) under CFR 1.114 of the above-identified application.

NOTE: 37 CFR 1.114 is effective on May 20, 2000. If the above- application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under CFR 1.53(d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 off. Gaz. Pat. Office

Submission under 37 CFR 1.114

☐ Previously submitted

☐ Consider the amendment(s)/reply under 37 CFR 1.116 previously filed on _____
(Any unentered amendment(s) referred to above will be entered).

☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

☐ Other _____

☒ Enclosed.

☒ Amendment/Reply

☐ Affidavit(s)/Declaration(s)

☐ Information Disclosure Statement (IDS)

☐ Other _____

Miscellaneous

☐ Suspension of action is requested under 37 CFR 1.103(c) for a period of _____ months.
The fee for this Suspension is (37 CFR 1.17(i)) \$130.00

☐ Other _____

CONTINUED EXAMINATION TRANSMITTAL
(RCE) (37 CFR 1.114) (continued)

PATENT APPLICATION

ATTORNEY DOCKET NO. 100200681-1

☒ RCE filing fee \$810.00

☒ A Petition for Extension of Time

☒ 1st Month
\$120

☐ 2nd Month
\$460

☐ 3rd Month
\$1050

☐ 4th Month
\$1640

☒ Please charge to Deposit Account 08-2025 the sum of \$ 930. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

☒ A duplicate copy of this transmittal letter is enclosed.

☒ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450

Date of Deposit: October 24, 2007

OR

☐ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.

Date of facsimile:

Typed Name: William D. Davis

Signature: William D. Davis

Respectfully submitted,

Michael D. Oldham, et al.

By William D. Davis

William D. Davis

Attorney/Agent for Applicant(s)

Reg No. : 38,428

Date : October 24, 2007

Telephone : (512) 858-9910



100200681-1

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael D. Oldham

Application No: 10/602,444

Filed: June 24, 2003

For: INTERMEDIATE PACKETIZING
OF VOICE DATA FOR
COMMUNICATION BETWEEN
CIRCUIT-SWITCHED NODES

Examiner: Addy, Thjuan Knowlin

Group Art Unit: 2614

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deposited with the United States Postal Service as
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OCTOBER 24, 2007

Date of Deposit

William D. Davis

MAIL STOP RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

In response to the Office Action dated JULY 24, 2007 applicant respectfully
requests reconsideration in view of the following remarks.

REMARKS

Applicant respectfully requests re-consideration of the application in view of the arguments presented below.

Summary of Office Action

Claims 1-20 are pending.

The previously submitted § 1.131 declaration was rejected.

Claims 1-20 were rejected as being anticipated by U.S. Patent Application Publication No. 2004/0032863 of Schoeneberger ("Schoeneberger")

Response to Examiner's Rejection of §1.131 Declaration

In response to the January 24, 2007 Office Action, applicant submitted a declaration in accordance with 37 CFR § 1.131 to establish an actual reduction to practice in this country prior to the effective date of the cited reference.

The Examiner has stated:

The evidence submitted is insufficient because, the conception occurs prior to the date of the Schoeneberger reference, but the constructive reduction to practice is afterward. Applicant must show evidence of facts by either affirmative acts or acceptable excuses in order to establish diligence. The statement of "application was prepared with due diligence" [sic] is insufficient. The critical period in which the diligence [sic] must be shown begins just prior to the effective date of the Schoeneberger reference, 08/16/02, and ends with the date of the constructive reduction to practice, 06/24/03.

(07/24/2007 Final Office Action, p. 2)

Although the Examiner is identifying requirements for a declaration of prior inventorship based upon constructive reduction to practice, applicant is not relying upon constructive reduction to practice. The declaration and evidence support applicant's claim of actual reduction to practice occurring prior to the earliest effective date of the Schoeneberger reference. When conception and reduction to practice occur prior to the effective date of the reference, *there is no requirement of proof of diligence* (see, 37 CFR §1.131; MPEP §715.07)

The Examiner has also stated:

Applicant is reminded that the 37 CFR 1.131 affidavit must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country.

(07/24/2007 Final Office Action, p. 2)

The relevant rule states in part:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based....*Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country...*

(Excerpt of 37 CFR § 1.131(a), *emphasis added*)

The applicant's 37 CFR § 1.131 declaration states in part:

3. In a laboratory located in Cupertino, California ("Laboratory") we constructed and tested a prototype of the claimed invention...

(§ 1.131 Declaration excerpt)

Cupertino, California is undeniably located within the United States. Applicant submits that the inventors' declaration affirmatively establishes that prior invention was established in the United States (which also happens to be a NAFTA country and a WTO member country). Applicant submits that the previously submitted declaration complies with the stated geographic requirements of 37 CFR § 1.131.

Applicant respectfully submits the Examiner's rejection of the 37 § 1.131 declaration has been overcome.

Response to 35 U.S.C. § 102 Rejections

Claims 1-20 were rejected as being anticipated by Schoeneberger. Schoeneberger has a filing date of December 20, 2002. Schoeneberger has a claim of priority to provisional application 60/404,076 filed August 16, 2002 (Provisional).

Without addressing the merits of Schoeneberger's claim of priority to the Provisional, applicant respectfully submits *the previously submitted § 1.131 Declaration establishes invention of the subject matter of the rejected claims prior to the effective date of Schoeneberger* regardless of whether the effective date is the filing date of the Provisional (August 16, 2002) or the nonprovisional (December 20, 2002).

In accordance with 37 C.F.R. § 1.131, applicant respectfully submits that Schoeneberger shall not bar the grant of a patent to the inventor.

Applicant respectfully submits the 35 U.S.C. § 102 rejections with respect to claims 1-20 and Schoeneberger reference have been overcome.

Conclusion

In view of the arguments presented above, applicant respectfully submits the applicable rejections and objections have been overcome. Accordingly, claims 1-20 should be found to be in condition for allowance.

If there are any issues that can be resolved by telephone conference, the Examiner is respectfully requested to contact the undersigned at (512) 858-9910.

Respectfully submitted,

Date October 24, 2007

William D. Davis
William D. Davis
Reg. No. 38,428